APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,934	12/31/2001	Keith Bussell	47661/SAH/S850	3791

23363	7590	09/29/2004	EXAMINER

CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

EXAMINER

HINZE, LEO T

ART UNIT	PAPER NUMBER
2854	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _13 July 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-9_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-9_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _31 December 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claims 1-9 are objected to because of the following informalities: In claim 1, line 7, it

appears that "postage" should be --postal--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
>
> in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
>
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
>
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
>
> manner in which the invention was made.

3.   Claims 1 and 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft

Word in view of Kara, US 5,819,240 (Kara).

a.   Regarding claim 1:

Microsoft Word teaches a method of printing postal indicia on a custom sized envelope

comprising: determining size of said custom sized envelope; selecting a height of said custom sized

envelope; selecting a width of said custom sized envelope (see "Envelope Size" window of Figure 1

of this action); rendering a postal indicia in accordance with the selected width and height of said

custom sized envelope (see "Preview" picture of envelope with postal indicia in "Envelope

Options" window of Figure 1 of this action); and printing the postal indicia on said custom sized envelope (see Figure 2 of this action).

Microsoft Word does not teach the postage indicia comprising machine readable data representing postage value.

Kara teaches printing postage on envelopes (col. 3, lines 17-22), integrating the postage printing system into a word processing system (col. 4, lines 30-36), and including machine readable data in the postage meter stamp (col. 4, lines 63-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Microsoft Word to include the ability to print postal indicia comprising machine readable data representing postage value, because one having ordinary skill in the art would recognize that this functionality would be advantageous for eliminating the need for stamps or other cumbersome methods of assuring proper postage was placed on envelopes.

b.   Regarding claim 3, the combination of Microsoft Word and Kara teaches all that is claimed as discussed in the rejection of claim 1 above.

Microsoft Word also teaches assigning said custom envelope a custom name. The "Add to Document" button in the "Envelopes and Labels" window of Figure 1 of this action allows the user to add the custom sized envelope to a document. The document may then be named and saved on the user's computer.
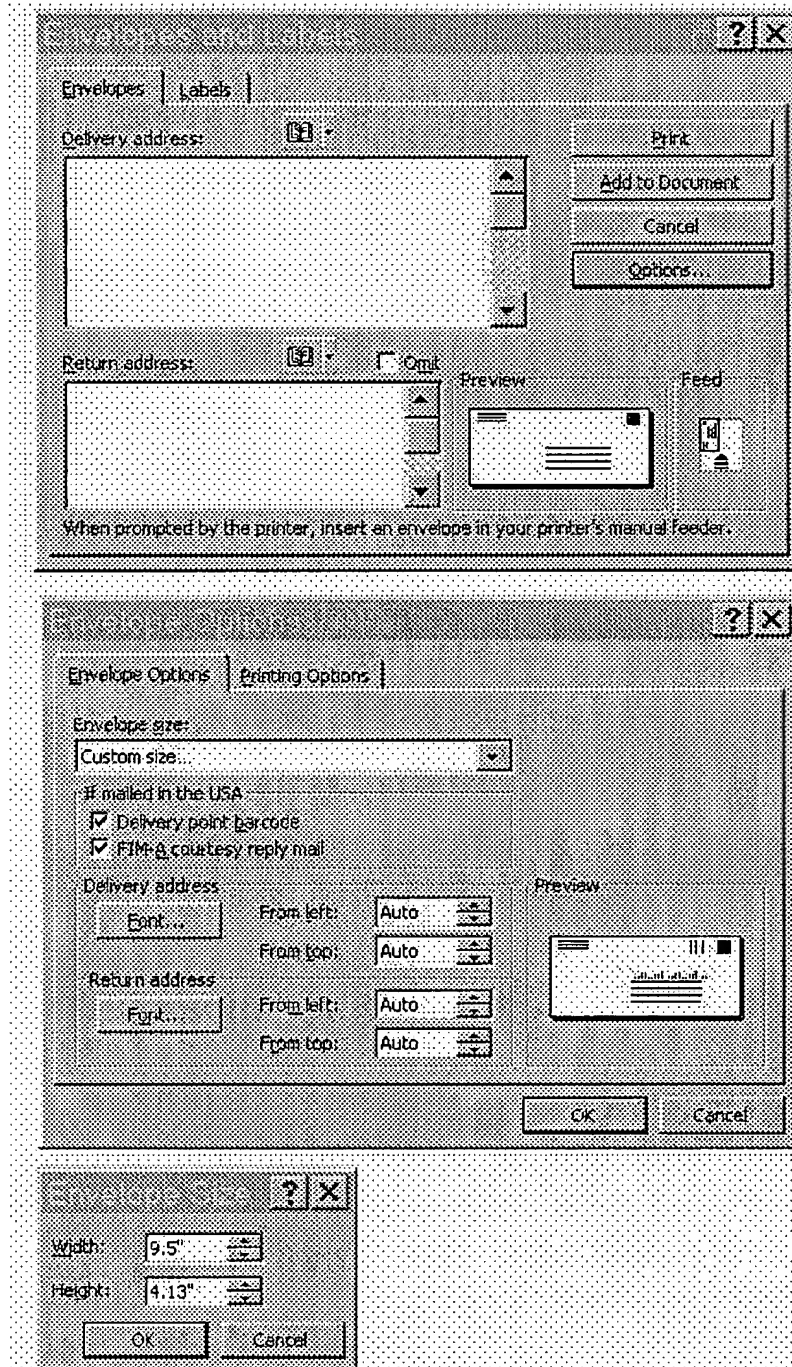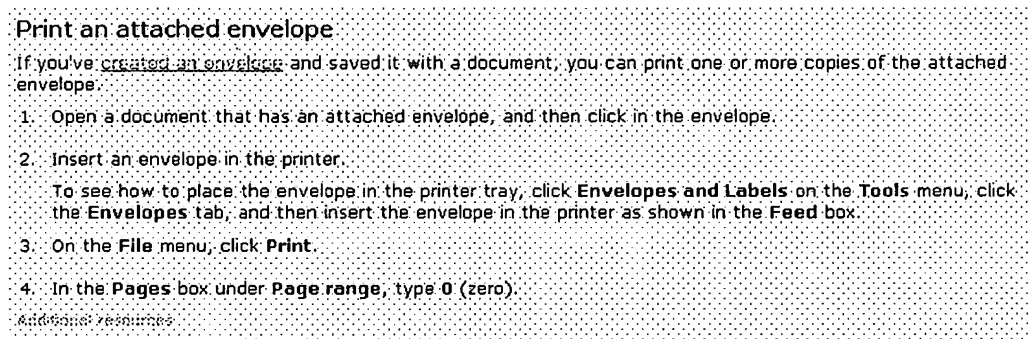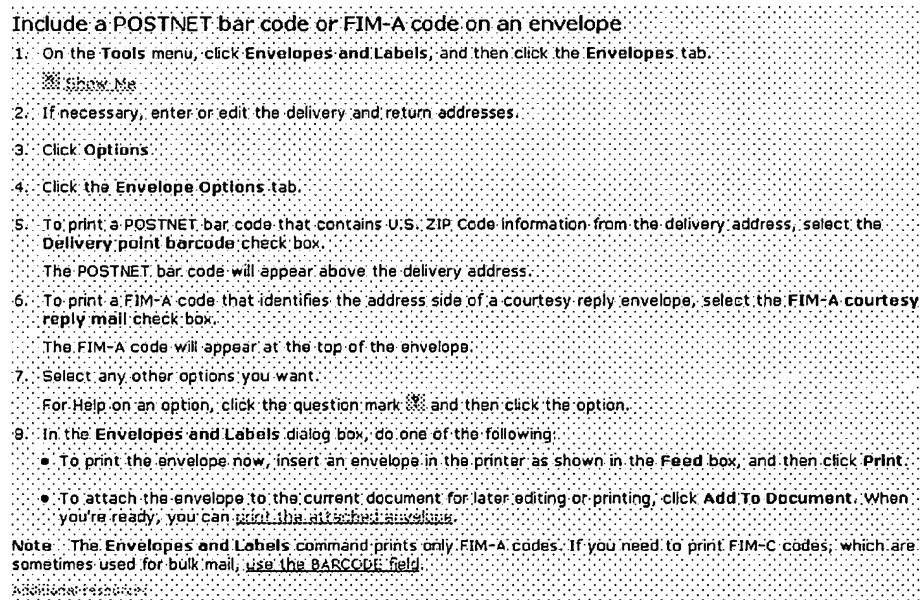
Figure 1 - Microsoft Word Envelope Menus

c.   Regarding claim 4, the combination of Microsoft Word and Kara teaches all that is claimed

as discussed in the rejection of claim 1 above.

Microsoft Word also teaches wherein printing a postal indicia on the custom sized envelope

comprises printing a two dimensional bar code onto the custom sized envelope (see "Preview"

picture of envelope with postal indicia in "Envelope Options" window of Figure 1 of this action).

Print an attached envelope

If you've created an envelope and saved it with a document, you can print one or more copies of the attached envelope.

1. Open a document that has an attached envelope, and then click in the envelope.

2. Insert an envelope in the printer.

    To see how to place the envelope in the printer tray, click **Envelopes and Labels** on the **Tools** menu, click the **Envelopes** tab, and then insert the envelope in the printer as shown in the **Feed** box.

3. On the **File** menu, click **Print**.

4. In the **Pages** box under **Page range**, type 0 (zero).

Additional resources

Figure 2 - Microsoft Word Help - Envelope printing instructions

Include a POSTNET bar code or FIM-A code on an envelope

1. On the **Tools** menu, click **Envelopes and Labels**, and then click the **Envelopes** tab.

    Show Me

2. If necessary, enter or edit the delivery and return addresses.

3. Click **Options**.

4. Click the **Envelope Options** tab.

5. To print a POSTNET bar code that contains U.S. ZIP Code information from the delivery address, select the **Delivery point barcode** check box.

    The POSTNET bar code will appear above the delivery address.

6. To print a FIM-A code that identifies the address side of a courtesy reply envelope, select the **FIM-A courtesy reply mail** check box.

    The FIM-A code will appear at the top of the envelope.

7. Select any other options you want.

    For Help on an option, click the question mark and then click the option.

8. In the **Envelopes and Labels** dialog box, do one of the following:

    • To print the envelope now, insert an envelope in the printer as shown in the **Feed** box, and then click **Print**.

    • To attach the envelope to the current document for later editing or printing, click **Add To Document**. When you're ready, you can print the attached envelope.

Note The **Envelopes and Labels** command prints only FIM-A codes. If you need to print FIM-C codes, which are sometimes used for bulk mail, use the BARCODE field.

Additional resources

Figure 3 - Microsoft Word Help - Inserting POSTNET bar code or FIM-A code on an envelope.

d.   Regarding claim 5, the combination of Microsoft Word and Kara teaches all that is claimed

as discussed in the rejection of claim 1 above.

Microsoft Word also teaches wherein printing a postal indicia on the custom sized envelope

further comprises printing a FIM on the custom sized envelope (see Figure 3 of this action).

e.   Regarding claim 6, the combination of Microsoft Word and Kara teaches all that is claimed

as discussed in the rejection of claim 5 above.

Microsoft Word also teaches wherein printing said FIM on the custom sized envelope

further comprises printing said FIM within a predefined distance of an edge of said custom sized

envelope (see Figures 1 and 4 of this action, and compare the position of the FIM indicia on the
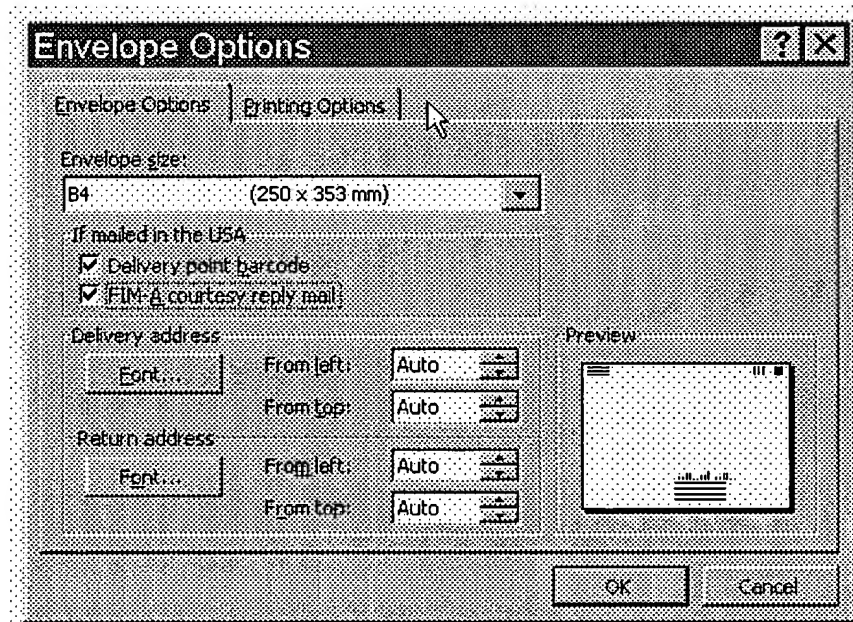
envelopes in the "Preview" windows).

Figure 4 - Microsoft Word - FIM barcode position moves based on envelope size.

f.   Regarding claim 7, the combination of Microsoft Word and Kara teaches all that is claimed as discussed in the rejection of claim 6 above.

Microsoft Word also teaches verifying the correct placement of the FIM on the custom sized envelope by visual inspection of the virtual envelope (see "Preview" box of the "Envelope Options" window in Figure 1 of this action).

g.   Regarding claim 8, the combination of Microsoft Word and Kara teaches all that is claimed as discussed in the rejection of claim 3 above.

Microsoft Word also teaches storing the selected width and height and custom name of the custom sized envelope on a printer server database. The "Add to Document" button in the "Envelopes and Labels" window of Figure 1 of this action allows the user to add the custom sized envelope to the document. The document may then be named and saved on the user's computer.

h.   Regarding claim 9, the combination of Microsoft Word and Kara teaches all that is claimed as discussed in the rejection of claim 1 above.

Microsoft Word also teaches wherein rendering a postal indicia in accordance with the selected width and height of the custom sized envelope comprises setting up a drawing surface ((see "Preview" box of the "Envelope Options" window in Figure 1 of this action) and shifting an origin of a virtualized sheet to position an image of the envelope in a printable area of the virtualized sheet (see Figures 1 and 4 of this action, and observe how the positions of the postal indicia and addresses on the envelopes are shifted in the "Preview" windows).

i.   Applicant should note that these features are available in Microsoft Word and can be accessed by selecting the "Tools" menu, and then selecting the "Envelopes and Labels" option.

4.   Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word in view of Kara and further in view of DeBarber et al, US 5,152,122 (DeBarber).

The combination of Microsoft Word and Kara teaches all that is claimed as discussed in the rejection of claim 1 above, except wherein determining the size of said envelope comprises determining the size of said envelop by placing the envelope on a template.

DeBarber et al. teach a method of working with custom sized envelopes, including inserting the envelope onto a template (52, Fig. 1), to determine the size of the envelope, and also to determine if the envelope is between the smallest and largest sizes that can be used, in order to eliminate trial and error of determine if the envelope is appropriately sized for the machine (col. 3, lines 28-38).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the printing method of Microsoft Word to include a template for determining the size of the envelope, because DeBarber et al. teach that using a template eliminates trial and error determinations of the appropriateness of the envelope size, and one having ordinary skill in the art would recognize this as advantageous for saving time.

Response to Arguments

5.   Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is (571) 272-2167. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Leo T. Hinze
Patent Examiner
AU 2854
23 September 2004

ANDREW H. HIRSHFELD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800